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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,457	06/13/2001	Christophe Alain Thuriereau	0537/178002	8829

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06/04/2003

Biomeasure Incorporated
27 Maple Street
Milford, MA 01757

EXAMINER

LIU, HONG

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/719,457

Applicant(s)

THURIEAU ET AL.

Examiner

Hong Liu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 08 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-3,5,7,9,11,22-24,27,28,30 and 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-3,5,7,9,11,22-23,30 and 33 is/are rejected.
- 7) ☐ Claim(s) 24,27 and 28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11. 6) ☐ Other: _____

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DETAILED ACTION

Claims 1-3, 5, 7, 9, 11, 22, 23, 24, 27, 28, 30, and 33 are pending in this application. Claims 4, 6, 8, 01, 12-21, 25, 26, 29, 31, 32, and 34-43 were indicated to be canceled in the response of May 8, 2003. This action is in response to the applicants' amendment and reply filed on May 8, 2003.

Response to Arguments

Applicants' arguments filed on May 8, 2003 have been fully considered but they are not persuasive. Rejections of claims 112, second paragraph, and 103(a) are maintained.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

The amended claims are object to as they still contain the non-elected subject matter that was withdrawn from consideration in the previous office action. Applicants' elected group II wherein A1 is $-C(=Y)-N(X1X2)$ in response to the restriction requirement. Accordingly, the structure search was limited to compounds wherein A1 is $-C(=Y)-N(X1X2)$. The patentability of other functional groups of A1 was not considered in the previous office action and thus these functional groups should not be included in the claims in case the compounds wherein A1 is $-C(=Y)-N(X1X2)$ are found allowable. Applicants are expected to further amend the claims so that the scope of the amended claims is consistent with that of the elected group.

Specification

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Claim Rejections - 35 USC § 112

The rejection of claims under 35 U.S.C., 112, first paragraph, is hereby withdrawn in view of applicant's amendment and arguments.

Claims 1-3, 5, 7, 9, 11, 22, 30, and 33 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. A proviso has been included in the claim (see amended claim 1). The proviso lacks description. Even negative limitations require a description. The MPEP at 2173.05(I) Negative Limitation states "Any negative limitation or exclusionary proviso must have basis in the original disclosure. See *Ex parte Grasselli*, 231USPQ 393 (Bd. App. 1983) *aff'd mem.*, 738 F. 2d 453 (Fed. Cir. 1984)" and further, "Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement." In the instant case, the new concept that has been introduced by the proviso is the specific relationships between R1, R2, R5, and R3. This specific relationship of connectivity was previously not disclosed. This notion that the definition of one variable depends on the definitions of other variables is new. The definition of a variable is no longer independent.

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The rejection of claims 1, 22, and 23 for the term “optionally substituted” under 35 U.S.C. 112, second paragraph is maintained for the reasons stated in the previous office. While it is true, as applicants argued, that this term appears in many patents, the issue is whether such a term can find support in the specification such that one of skill in the art will be able to determine the metes and bounds of the substituents. In the instant case, there is no definition for “optionally substituted” in the specification. Nor is there any definition for the term “substituted” in the phrase “unsubstituted or substituted” in the specification.

The remaining rejections under 35 U.S.C. 112, second paragraph, are hereby withdrawn in view of the amendments.

Claim Rejections - 35 USC § 103

Claims 1, 2, 5, 7, 22, and 30 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Yatabe et al. (WO 98/27108) for reasons of previous office action which are incorporated herein by reference. Applicants’ argument filed on May 8, 2003 have been fully considered but they are not found persuasive. Although applicants included a proviso to further distinguish applicants’ compounds from the reference compounds, the instantly claimed compounds are still generically embraced by the reference compounds. For example, R3 after amendment can no longer be a hydrogen substituent. But R3 can be an alkyl, the corresponding functional group in the reference, R2, can also be alkyl. R5 of the present invention can be substituted alkyl whereas R5 of the reference can also be phenyl(lower)alkyl. In addition, applicants’ arguments of bond connectivity of R5 and R6 not understood. Applicants argued that R5 is situated between two carbon atoms of the heterocyclic ring whereas R6 is bonded to a carbon and a nitrogen atom of the heterocyclic ring. As the Examiner sees it, R5, like R6 is also

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situated between a carbon and a nitrogen of the imidazole, albeit the nitrogen bonded by R5 and R6 are different. For this reason, Example 27 is still deemed as a positional isomer of the instantly claimed compounds.

Claim Objections

Claims 24, 27, and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. None of the prior art of record nor a search in the pertinent art area teaches the compounds in these claims.

Conclusion

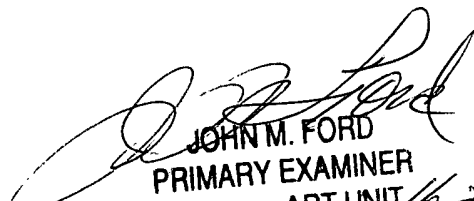
1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication should be directed to Examiner Hong Liu whose telephone number is (703) 306-5814. The examiner can normally be reached on Monday

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through Friday from 8:30 AM to 6:00 PM. If attempts to reach the examiner by the phone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached at (703) 308-4716. The fax phone number for this group is (703) 308-4734 for "unofficial" purposes and the actual number for official business is (703) 308-4556. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose number is (703) 308-1235.


JOHN M. FORD
PRIMARY EXAMINER
GROUP - ART UNIT 1624

hl
May 28, 2003


Mukund Shah
Supervisory Patent Examiner
Art Unit 1624